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PATENT

### REMARKS

Claims 1-24 were pending in this application.

Claims 1-24 have been rejected.

Claims 3-6, 9-12, 15, 17-19, 22, and 24 have been amended.

Claims 1-24 remain pending in this application.

Reconsideration and full allowance of Claims 1-24 are respectfully requested.

#### **I. AMENDMENTS TO CLAIMS**

The Applicant has amended Claims 3-6, 9-12, 15, 17-19, 22, and 24 to resolve a potential ambiguity in the claims. In particular, these claims recited "first data" without later reciting any "second data." The Applicant has amended Claims 3-6, 9-12, 15, 17-19, 22, and 24 to refer to "data" rather than "first data." The Applicant respectfully requests entry of these amendments.

#### **II. REJECTIONS UNDER 35 U.S.C. § 103**

The Office Action rejects Claims 1-19 under 35 U.S.C. § 103(a) as being unpatentable over Admitted Prior Art ("APA") in view of U.S. Patent No. 6,292,187 to Gibbs et al. ("*Gibbs*") and Bahl, "Software-only Compression, Rendering, and Playback of Digital Video" ("*Bahl*"). The Office Action rejects Claims 20-24 under 35 U.S.C. § 103(a) as being unpatentable over APA, Gibbs, and Bahl in further view of U.S. Patent No. 5,751,962 to Fanshier et al. ("*Fanshier*"). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of

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establishing a *prima facie* case of obviousness. (MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (MPEP § 2142).

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Claim 1 recites a "user interface application program" that is associated with a "user interface." Claim 1 also recites a "reverse DAPD application programming interface (API)." The user interface application program is executed by a "processing system," and the reverse DAPD API is executed by a processor in a "digital audio playback device." In addition, Claim 1 recites bi-directional control. The "user interface application program" executed by the processing system controls the digital audio playback device. The reverse DAPD API causes the processor in the digital audio playback device to control the user interface.

*APA* recites a system where there is only uni-directional control between a processing system (such as a PC) and a digital audio playback device. For example, a user interface on the PC uses an API on the digital audio playback device to control the digital audio playback device. (*Application*, Page 2, Lines 4-11; Page 4, Lines 8-17). *APA* lacks any mention of bi-directional control in this setup. For example, *APA* lacks any mention that the digital audio playback device is controlled by the PC and that the digital audio playback device controls the user interface of the PC.

*Gibbs* also lacks any mention of bi-directional control between a digital audio playback device and a user interface of an external processing system. Instead, *Gibbs* recites a system of uni-directional control between a network and a device. (*Abstract*). The device provides a user interface to users that is controlled by a set of "mattes." (*Abstract*). The mattes control the ways in which components in the user interface are displayed. (*Abstract*).

*Gibbs* simply recites a system where an end user device is controlled in a uni-directional manner. Also, the user interface of *Gibbs* is not associated with a "user interface application program" that is used to control an external device. Instead, the user interface of *Gibbs* is used to

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control the device in which it resides. At most, *Gibbs* might suggest that the PC of *APA* be allowed to control the user interface of the digital audio playback device in a uni-directional manner. *Gibbs* lacks any mention of bi-directional control between a processing system and a digital audio playback device. As a result, the proposed *APA-Gibbs* combination fails to disclose, teach, or suggest bi-directional control between a processing system and a digital audio playback device.

Regarding *Bahl*, the Applicant initially notes that the Patent Office failed to provide a complete copy of the *Bahl* reference. Moreover, the portions of *Bahl* cited and relied upon by the Office Action were not provided to the Applicant. The Applicant respectfully requests that the Patent Office provide a complete copy of the *Bahl* reference in the next official communication, which would allow the Applicant to identify the specific portions of *Bahl* relied upon by the Office Action.

As with *Gibbs*, *Bahl* lacks any mention of bi-directional control between a digital audio playback device and an external processing system. Instead, *Bahl* simply recites various video coders and decoders. (See, e.g., Figures 2-3). *Bahl* also recites a software video library that is accessible through an API and used in conjunction with a video decoder. (Page 14, "Architecture" section; Figure 9). A video player implementing the decoder provides various control functions, such as fast forward and reverse. (Page 18, First paragraph).

*Bahl* simply recites a system that may retrieve video information from a library using an API and that a user interface may be used to control the playback of the video information. *Bahl* lacks any mention of bi-directional control, where a "user interface application program" in a processing system controls a digital audio playback device and a "reverse DAPD application programming

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interface (API)" in the digital audio playback device controls a "user interface" associated with the "user interface application program." Because *Bahl* lacks any mention of bi-directional control between a processing system and a digital audio playback device, the proposed *APA-Gibbs-Bahl* combination fails to disclose, teach, or suggest bi-directional control between a processing system and a digital audio playback device.

For these reasons, the proposed *APA-Gibbs-Bahl* combination fails to disclose, teach, or suggest all elements of Claim 1. As a result, the Office Action fails to establish a *prima facie* case of obviousness against Claim 1 (and its dependent claims).

Claims 7 and 13 both recite a "user interface application program" in a "processing system" that controls a "digital audio playback device." Claims 7 and 13 also recite a "reverse DAPD application programming interface (API)" that enables the digital audio playback device to control a "user interface" associated with the user interface application program.

As described above, each of *APA*, *Gibbs*, and *Bahl* fails to disclose, teach, or suggest bi-directional control between a processing system and a digital audio playback device, where a user interface application program controls the digital audio playback device and a reverse DAPD API enables the digital audio playback device to control a user interface associated with the user interface application program. At most, the proposed *APA-Gibbs-Bahl* combination discloses uni-directional control of an end user device.

For these reasons, the proposed *APA-Gibbs-Bahl* combination fails to disclose, teach, or suggest all elements of Claims 7 and 13. As a result, the Office Action fails to establish a *prima facie* case of obviousness against Claims 7 and 13 (and their dependent claims).

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Claim 20 recites a "user interface application program" in a "processing system" that controls a "digital audio playback device." Claim 20 also recites a "reverse DAPD application programming interface (API)" that enables the digital audio playback device to control a "user interface" associated with the user interface application program.

As described above, each of *APA*, *Gibbs*, and *Bahl* fails to disclose, teach, or suggest bi-directional control between a processing system and a digital audio playback device. In particular, each reference fails to disclose, teach, or suggest a user interface application program that controls the digital audio playback device and a reverse DAPD API that enables the digital audio playback device to control a user interface associated with the user interface application program. The Office Action cites *Fanshier* only as disclosing instructions stored on a removable storage medium. The Office Action does not rely on *Fanshier* as disclosing, teaching, or suggesting bi-directional control between a processing system and a digital audio playback device.

For these reasons, the proposed *APA-Gibbs-Bahl* combination fails to disclose, teach, or suggest all elements of Claim 20. As a result, the Office Action fails to establish a *prima facie* case of obviousness against Claim 20 (and its dependent claims).

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection and full allowance of Claims 1-24.

### **III. CONCLUSION**

The Applicant respectfully asserts that all pending claims in the application are in condition for allowance and respectfully requests an early allowance of such claims.

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**SUMMARY**

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at [wmunck@davismunck.com](mailto:wmunck@davismunck.com).

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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Date: Nov 2, 2004



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